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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,686	02/14/2002	Yoshiharu Matahira	00225CIP/HG	2395

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EXAMINER

OSTRUP, CLINTON T

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 04/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/076,686

Applicant(s)

MATAHIRA ET AL.

Examiner

Clinton Ostrup

Art Unit

1614

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 4/07/04 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 4-6 and 9-25.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 2. NOTE: The amendment will not be entered because it does not place the application in condition for allowance or in better condition for appeal. The newly submitted claim limitations, for example amending the claims from "skin beautification" skin to the "amelioration of rough skin and wrinkles" would require further consideration and an additional search. Moreover, the term "rough" is a relative term because the metes and bounds of what applicant considers "rough" are not defined. The declaration of MATAHIRA is not convincing because MATAHIRA describes an increase in moisture content of skin and improvement in desiccation of skin and that a collagen peptide prepared from cod bone is more susceptible to the enzymatic digestion than animal derived collagen. However, these limitations were not presented in the rejected claims or in the newly amended claim and it would require an additional search and further consideration to determine the obviousness of obtaining collagen from a cod bone. Moreover, it should also be noted that applicant is not claiming the collagen derived from cod bone, but is claiming collagen from the skin, or any adjacent part thereof, or bone or any adjacent part thereof, of a fish (i.e. not cod bone). Thus, the declaration does not compare the prior art to the breadth of the newly submitted claim limitations and even if it did, it would require a new search and further consideration to determine the obviousness of using collagen derived from cod bone verses collagen derived from other sources.

Continuation of 5. does NOT place the application in condition for allowance because: Applicants arguments that the therapeutic effect to obtain improvement of skin conditions is considerably different has not been found convincing. The In re Kerkoven case law describes that "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose..." not that they must perform the purpose by the way. In the instant case Murad teaches N-acetylglucosamine in an orally administered pharmaceutical composition for the treatment of skin conditions, including the treatment of skin wrinkles, by administering said composition in the form of capsules and tablets and containing amounts of N-acetylglucosamine, BIKEN CORP teaches a health food which has various beauty making and health effects, such as ameliorating rough, dry skin and fine wrinkles comprising hyaluronic acid, chondroitin sulfate, collagen, nucleic acid, and docosahexaenoic acid, and Haynes et al., teach a method of producing N-acetyl-D-glucosamine by the enzymatic hydrolysis of chitin. Moreover, applicant's argument that the present invention obtains "additive and/or synergistic effects" is not convincing because these limitations are not claimed.



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